

REMARKS

Applicants have studied the Office Action dated November 28, 2003 and have made amendments to the claims. Claims 4, 11 and 20-22 have been cancelled without prejudice. No new matter has been added. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 1-3, 5-10 and 12-19 are pending. Reconsideration and further examination of the pending claims in view of the above amendments and the following remarks is respectfully requested. In the Office Action, the Examiner:

- objected to claim 13 because of a typographical error;
- rejected claims 1-13, 15-17 and 20-22 under 35 U.S.C. §102(e) as being anticipated by Herz et al. (U.S. 6,571,279); and
- rejected claims 14 and 18-19 under 35 U.S.C. § 103(a) as being unpatentable over Herz et al. (U.S. 6,571,279) in view of Burke et al. (U.S. 6,604,681) and Stewart (U.S. 6,452,498).

Objection to Claim 13

As noted above, the Examiner objected to claim 13 because of a typographical error. Namely, the word "persnl" should read "personal." The Applicants have amended the claim 13 to correct the error. No new matter has been added. Accordingly, the Applicants respectfully submit that the Examiner's objection has been overcome.

Overview of the Present Invention

Preferred embodiments of the present invention are directed to a combination of Global Positioning System (GPS), Personal Data Assistant (PDA), and wireless communications in order to create a more personalized advertising experience. The invention creates and presents advertising content founded on individual user profiles

ARC9-2000-0048-US1

8

09/757,901

integrated with the physical geographic location of a consumer. The present invention solves the problem of advertising tailored so that it is appropriate to both the user and their current location by including a customer's profile and his / her current location into the advertising message. Also, the invention integrates location tracking, e.g. GPS technology, with a personal electronic calendaring system. Further, an advertising message is more personalized by using a relative address / directions that start from the current customer's location. This information could be provided in the form of driving directions, using the current physical position of the user as a start address. See Abstract of the specification of the Applicants' invention.

Rejection under 35 U.S.C. §102(e)

As noted above, the Examiner rejected claims 1-13, 15-17 and 20-22 under 35 U.S.C. §102(e) as being anticipated by Herz. Independent claims 20-22 and dependent claims 4 and 11 have been cancelled without prejudice. Independent claims 1, 9 and 13, have been amended to clarify the present invention. In view of the foregoing amendments and the remarks below, the Applicant respectfully traverse the Examiner's rejection.

The present invention, as defined in amended independent claims 1 and 9, includes a step of having a merchant server, or second processing unit, register with the present invention so as to provide targeted advertising to the mobile telephones, or information processing units. Specifically, amended independent claim 1 includes the step of:

"a registration step of receiving registration information from a second hub processing unit and from information processing units associated with the network, wherein the second hub processing unit is a merchant server"

Further, amended independent claim 9 includes the step of:

ARC9-2000-0048-US1

9

09/757,901

*"the method of personalized profile based advertising on a second hub processing unit comprising a merchant server, comprising the steps of:
registering by sending registration information to a hub processing unit"*

Therefore, both independent claims 1 and 9 include the step of having a second processing unit, or merchant server, registering with the present invention so as to provide targeted advertising based on the location of the mobile telephones, the profiles of the mobile telephone users, or both. This described in the Summary of the Invention of the specification of the Applicants' invention, reproduced below in relevant part:

The location tracking component determines where the customer is at any given moment. This location information is used to create advertising for products or services which are in close proximity to the customer's current location. For example, while traveling down the highway late at night, a user is alerted to things ahead that match the user's profile. If there is a motel coming up the system displays an ad from the motel including its location, special room rates and more. A personal electronic calendaring system . . . is used to retrieve the customer's profile information. This profile comprises information about which products or services a customer is interested in, what he or she is looking for, what he or she is doing right now and what he or she is going to do. This information is either obtained from calendar entries or stored in the profile setup of the calendaring system. This collection of information allows for the creation of personalized advertising which depends on customer's interests. For example, a computer shop knows that a particular customer is interested in buying scanner hardware. The computer shop then sends a personalized advertising message about scanner(s) technology to this customer based on the customer's profile

ARC9-2000-0048-US1

10

09/757,901

and location. (Emphasis added.)

The Examiner at pages 3 and 4 of the Office Action states that Herz discloses the step of having a merchant server, or second processing unit, register with a targeted advertising system so as to provide targeted advertising to a plurality of mobile telephones, or information processing units. Specifically, the Examiner refers us to col. 9 lines 33-45, col. 13 lines 18-47, col. 15 line 55 to col. 16 line 34 and col. 17 lines 35-65. However, careful reading of those passages of Herz reveals that none of these passages specifically refer to a system wherein a merchant server, or second processing unit, registers with a targeted advertising system so as to provide targeted advertising to a plurality of mobile telephones, or information processing units. Registering involves the provision of identifying information with a central registrar for the purpose of logging the presence of an entity. This step allows the present invention to log the presence of a merchant server so as to allow the merchant server to participate in the targeted advertising system of the present invention, wherein merchant servers are allowed to provide targeted advertising to a plurality of mobile telephones.

Therefore, amended independent claims 1 and 9 distinguish over Herz because Herz does not teach or disclose "a registration step of receiving registration information from a second hub processing unit, wherein the second hub processing unit is a merchant server." Herz does not teach, anticipate, or suggest all of the recited elements of independent claims 1 and 9. Further, because independent claims 1 and 9 distinguish over Herz, dependent claims 2-3, 5-8, 10 and 12-13, which depend from independent claims 1 and 9, also distinguish over Herz. Therefore, Herz does not teach, anticipate or suggest all of the recited elements of dependent claims 2-3, 5-8, 10 and 12-13. Therefore, the Examiner's rejection should be withdrawn and it is respectfully submitted that claims 1-3, 5-8, 9-10 and 12-13 are in a condition for allowance.

The Examiner's rejection of claims 15-17 are addressed in the section below.

ARC9-2000-0048-US1

11

09/757,901

Rejection under 35 U.S.C. §103(a)

As noted above, the Examiner claims 14 and 18-19 under 35 U.S.C. § 103(a) as being unpatentable over Herz in view of Burke and Stewart. In view of the foregoing amendments and the remarks below, the Applicants respectfully traverse the Examiner's rejection.

On page 12 of the Examiner's Office Action, the Examiner states that Herz fails to teach the following elements of independent claim 14:

"and if a product matches the user profile then performing the sub-steps of:

generating a first map;

sending the first map to the active information processing unit;

wherein if no product matches the user profile then performing the sub-steps of:

generating a second map;

sending the second map to the active information processing unit;

wherein if a user profile does not exist then performing the sub-steps of:

generating a third map;

sending the third map to the active information processing unit;

wherein if the user location records indicate that a user is not in a sales location then performing the sub-steps of:

loading map information from a second map database;

determining user direction from the user location records;

creating a fourth map;

sending the fourth map to the active information processing unit;

wherein if the user location records do not exist then performing the sub-steps of:

ARC9-2000-0048-US1

12

09/757,901

receiving an error message from the active information processing unit."

The Examiner goes on to state on pages 13 and 14 of the Office Action that Burke and Stewart combined with Hertz teach all elements of the independent claim 14.

Burke is directed to an evaluative shopping assistant system and method to provide a consumer with information about a product the consumer is interested in. The system includes a hand-held device having a bar code reader or other unique means of entering a product identifier, and a display mechanism. The hand-held device is connected via wired or wireless connection to a computer that is connected to a database of information. In use, the hand-held device reads the bar code, sends the bar code information to the computer, and the computer retrieves the appropriate information about the product from the database. The computer then sends the retrieved information to the hand-held device for display of the retrieved information. The information stored on the database may include information provided by the manufacturer, the retailer (or, more generally, seller), or consumers. When consumer information is provided, a consumer may view qualitative information, such as other consumer's opinions about the product, not normally provided by the manufacturer or seller. The system allows a seller to continuously collect marketing information about products and gives consumers a sense of community by allowing them to share information and opinions about products.

Burke, however, is silent on targeted advertising and does not even mention advertising at all. That is, Burke is directed towards a system wherein a user or consumer solicits information on a particular product, not towards a system wherein advertisers or merchants provide unsolicited targeted advertising to a consumer based on the consumer's location and profile. Thus, Burke cannot properly be combined with Hertz or Stewart to anticipate the present invention because doing so would destroy the intent, purpose or function of Burke.

ARC9-2000-0048-US1

13

09/757,901

The Federal Circuit has consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the *prima facie* case of obviousness can not be properly made. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The intent, purpose and function of Burke is to allow a user or consumer to solicit information on a particular product; in contrast, the intent and purpose of the present invention is to provide targeted advertising to a consumer based on the consumer's location and profile. The Applicants respectfully submit that modifying Burke to provide targeted advertising to consumers based on their location and profile destroys the intent of Burke. Accordingly, the present invention is distinguishable over Hertz taken alone and/or in view of Burke and Stewart for this reason.

Further, the combination of Hertz, Burke and Stewart as suggested by the Examiner, destroys the intent and purpose of Burke taken alone and/or in view of with Hertz and Stewart. The Applicants respectfully submit that modifying Burke to provide targeted advertising to consumers based on their location and profile destroys the intent of Burke. Accordingly, the present invention is distinguishable over Hertz taken alone and/or in view of Burke and Stewart for this reason as well.

Continuing further, when there is no suggestion or teaching in the prior art for provide targeted advertising to a consumer based on the consumer's location and profile the suggestion can not come from the Applicant's own specification. As the Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference is silent does not even suggest, teach nor mention advertising.

ARC9-2000-0048-US1

14

09/757,901

Therefore, independent claim 14 distinguishes over Hertz taken alone and/or in view of Burke and Stewart because the combination does not teach or disclose all elements of independent claim 14. Further, because independent claim 14 distinguishes over Hertz taken alone and/or in view of Burke and Stewart, dependent claims 15-19, which depend from independent claim 14, also distinguish over Hertz taken alone and/or in view of Burke and Stewart. Therefore, Hertz taken alone and/or in view of Burke and Stewart does not teach, anticipate or suggest all of the recited elements of dependent claims 15-19. Therefore, the Examiner's rejection should be withdrawn and it is respectfully submitted that claims 14-19 are in a condition for allowance.

CONCLUSIONS

The remaining cited references have been reviewed and are not believed to effect the patentability of the claims as amended.

In this response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith to the disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §§ 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

ARC9-2000-0048-US1

15

09/757,901

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

PLEASE, if for any reason the Examiner finds the application other than in condition for allowance, the Examiner is invited to call either of the undersigned attorneys at (561) 989-9811 should the Examiner believe a telephone interview would advance the prosecution of the application.

Respectfully submitted,

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ARC9-2000-0048-US1

16

09/757,901